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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/072,382  | 02/06/2002  | James D. Pravetz     | 07844-494001        | 2559             |
| 21876   | 7590        | 03/07/2007           | EXAMINER            |                  |
| FISH & RICHARDSON P.C.<br>P.O. Box 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | STORK, KYLE R       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2178                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE                                | MAIL DATE   | DELIVERY MODE        |                     |                  |
| 3 MONTHS  | 03/07/2007  | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                           |                   |
|------------------------------|---------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)      |
|                              | 10/072,382                | PRAVETZ, JAMES D. |
|                              | Examiner<br>Kyle R. Stork | Art Unit<br>2178  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 January 2007.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-32 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This final office action is in response to the amendment filed 29 January 2007.
2. Claims 1-32 are pending. Claims 1 and 17 are independent.

The rejection of claims 1-32 under 35 USC 112 has been withdrawn as necessitated by the amendment.

The rejection of claims 1-32 under 35 USC 102 over Microsoft® Outlook® 2000 (1999, hereafter Outlook) has been withdrawn as necessitated by the amendment.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft® Outlook® 2000 (1999, hereafter Outlook), and further in view of Applicant's Admitted Prior Art (Specification, filed 6 February 2002, hereafter AAPA).

As per independent claims 1 and 17, Outlook discloses a method for signing an electronic document, the method comprising:

- Establishing an electronic signature appearance for an electronic signature, an electronic signature appearance comprising a visual manifestation of a signer's signature on the electronic document (Figure 1: Here, a user is able to select an

appropriate signature for a document (Figure 1, item 1). The electronic signature is previewed in a bounding region (Figure 1, item 2))

- Determining a bounding region on the electronic document for the display of the electronic signature appearance (Figure 3, item 1: Here, the signature is affixed at the end of the document)
- At the time of electronically signing an electronic document, previewing the electronic signature in the bounding region, where the electronic signature appearance can be edited based on a user input after previewing the electronic signature appearance and before electronically signing the electronic document (Figure 2, item 1: Here, the user may edit the text to appear in the signature; Figure 1, item 1: Here, as with any other text within a document (in this instance, an electronic mail message), the signature may be edited in a WYSIWYG fashion)
- Signing the electronic document with an electronic signature, the electronic signature appearance being included in the electronic document signed with the electronic signature (Figure 3)

Outlook fails to specifically disclose the electronic signature comprising code derived from a signed electronic document and a private key. However, AAPA discloses a conventional public-private key using a hash function to sign the electronic document using the private key (page 1, lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined AAPA

with Outlook, since it would have allowed a user to uniquely encode a document to ensure verification of the contents of a document (AAPA: page 1, lines 18-25).

As per dependent claims 2 and 18, Outlook discloses the method further comprising configuring the electronic signature at the time of signing the electronic document (Figure 3: Here, the signature is added and editable at the time of signing the document).

As per dependent claims 3 and 19, Outlook discloses the method wherein configuring the electronic signature appearance comprises interacting with a user signing the electronic document (Figures 3 and 5, item 2: Here, the text "(HERE IS A MODIFICATION)" has been added by the user).

As per dependent claims 4 and 20, Outlook discloses wherein configuring the electronic signature appearance comprises receiving user input activating controls for controlling textual and graphic elements included in the electronic signature appearance (Figure 1, item 1: Here, a user selects from a plurality of signatures to apply to a document).

As per dependent claims 5 and 21, Outlook discloses wherein the controls comprise one or more of checkboxes and buttons (Figure 1, item 3: Here, after a user selects a signature, the user activates a button, in this instance the "OK" button, to select the signature).

As per dependent claims 6 and 22, Outlook discloses wherein previewing the electronic signature appearance includes previewing a display in a configuration dialog

box of the electronic signature appearance within the bounding region and the controls for controlling textual and graphic elements (Figures 1 and 2).

As per dependent claims 7 and 23, Outlook discloses wherein previewing the electronic signature appearance includes displaying the electronic signature appearance within the bounding region on a display of the electronic document (Figure 3).

As per dependent claims 8 and 24, Outlook discloses including in the electronic signature appearance textually elements automatically copied from a certificate of a user signing the electronic document (Figures 1 and 3; help topic from Outlook “Create a signature for messages:” Here, the signature is copied from a template).

As per dependent claims 9 and 25, Outlook discloses establishing an electronic signature appearance comprises receiving user input selecting an electronic signature appearance from one or more existing electronic signature appearances (Figure 1, item 1).

As per dependent claims 10 and 26, Outlook discloses establishing an electronic signature appearance comprises interacting with a user to create an electronic signature appearance (Figures 1 and 2; help topic “Create a signature for messages”).

As per dependent claims 11 and 27, Outlook discloses establishing an electronic signature appearance comprises receiving an electronic signature appearance pre-configured by an author of the electronic document to be signed (Figure 3: Here, the signature appearance was pre-configured by an author via the interface of Figures 1 and 2).

As per dependent claims 12 and 28, Outlook discloses determining a bounding region on the electronic document for the electronic signature appearance comprises interacting with a user signing the electronic document to establish a bounding region (Figures 3-4).

As per dependent claims 13 and 29, Outlook discloses previewing the electronic signature appearance comprises previewing the electronic signature appearance configured to fit within the bounding region (Figures 3-4).

As per dependent claims 14 and 30, Outlook discloses wherein determining the bounding region on the electronic document for the electronic document for the electronic signature appearance comprises establishing a bounding region pre-set by the author of the electronic document (Figures 3-4).

As per dependent claims 15 and 31, Outlook discloses determining an optimal layout of the electronic signature based on the dimensions of the bounding region (Figure 1, item 2; Figures 3-4).

As per dependent claims 16 and 32, Outlook discloses determining optimal dimensions of the bounding region based on the electronic signature appearance (Figures 4-5).

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyle R Stork  
Patent Examiner  
Art Unit 2178

krs



CESARIO PAULA  
PRIMARY EXAMINER